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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,733

07/02/2003

Charles Frederic Paul

6473P002

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05/16/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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EXAMINER

FRECH, KARL D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,733

Applicant(s)

PAUL ET AL.

Examiner

Karl D. Frech

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-14 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant's request for continued examination and arguments filed 4/20/06 have been considered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 19 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan 6,572,020.

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Barkan discloses a portable bar code scanner 30 that includes a connector socket (port) 46 for the transfer (uploading) of collected optical code data to a data-handling terminal (col 5 lines 38+). Electronic (col 10 lines 2+) and physical (600 fig 14) coupons are scanned. These codes may be physically or electronically scanned (col 15 lines 22+). Memory for storing coupon data is disclosed (col 10 lines 1+). Storing the coupon data in digital form is inherent. The coupons contain at least manufacture identity and product identity information, expiration date, offer (value) code (col 15 lines 1+). An optical interface is disclosed including an optical code-reading module (211, col 8 lines 2+, fig 10). A flexible button pad (col 6 lines 40+) is disclosed. A docking station 32 is also disclosed. Unique identification information related to the individual scanner is also disclosed (col 9 lines 43+). The scanner can be used at a kiosk (col 6 lines 25+). Barkan does not specifically disclose the "matching" of stored coupon data to check for a match as in claim 19. However, if not inherent, Official Notice is taken that coupon correlation in hand held scanners between the stored information on the scanner and that in a host system is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to "match" the stored information of Barkan. This would ensure that there was a correlation between what the customer has scanned into the scanner's memory and that which a host has been set to receive. This would help deter theft and pilfering.

6. Claims 1-8,15-18, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan 6,572,020 in view of Pearlman et al US 2003/0233276.

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Barkan discloses that which is seen above. Barkan does not specifically disclose redeeming a coupon by determining if a purchase satisfies a set of redemption rules or conditions as in claims 7,8. However, if not inherent, Official Notice is taken that accepting coupons only within a set of conditions is old and well known. Further, Pearlman discloses a coupon with an expiration date (see figures), i.e. redemption rule or condition. It would have been obvious to a person of ordinary skill in the art at the time of the invention to ensure that the coupon redemption met a set of conditions. This would ensure that invalid coupons were not "granted" (examiner's words). For example, one condition would be only to accept a coupon that did not post date a set expiration date. Barkan does not specifically disclose the display of claim 12, or the scroll key of claim 13 for scrolling through the display. However, push button input is disclosed as seen above. Official Notice is taken that displays on hand held bar code scanners and appropriate button input for scrolling through the display are old and well known. Further, Pearlman discloses a hand held device which has a display 12 for displaying a bar code 14. It is noted that the device of Pearlman has an internal memory for storing the bar code ([0108], for example). It is also disclosed that the user of the device may search for coupons or vouchers by using a menu on the device [0130] It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate a known display and scroll button into the apparatus of Barkan. This would allow a user to review and navigate the information held in the scanner.

7. Claims 9-14 are allowed for those reasons as set forth by applicant in the submission of 4/20/06.

8. Applicant's arguments filed 4/20/06 have been fully considered but they are not persuasive. Applicant argues that Barkan and Pearlman do not disclose information including store credit accessible only by the in-store server. The examiner respectfully disagrees. Re claim 1, this claim does not recite the "in-store" server. Re claim 15, although this claim does recite an "in-store" server, the claim does not positively associate the "in-store" server to a specific location. "Stores" are now commonly, individual locations, or a plurality of locations connected via networks, or even virtual stores. Thus "in-store" is rightfully interpreted as within a store, or store network, or store system in general.

9. Applicant argues that Barkan and Pearlman do not disclose "... a proof of purchase comprises (i) a date stamp, (ii) a time stamp, (iii) a retail store location where the coupon was redeemed and aisle location of a product purchased, (iv) an original selling price purchased product, (v) a face value of the scanned coupon redeemed, and (vi) additional discount offered by the retailer". However, it is inherent that for accounting purposes, records of coupons scanned would contain the face value of the coupon.

10. In response to applicant's contest against the holding of Official Notice. Scroggie et al 5,970,469 shows in figure 1.1 "Only at Ralph's" and an expiration date. Scroggie et al US 2005/0102181A1 shows in figure 11 "When You Buy X Amount of a Certain Type" and an expiration date. That is, both Scroggies disclose "conditional" coupons. Cargin, Jr. et al 6,895,419 discloses a portable data collection terminal with a display.

11. This is a RCE of applicant's earlier Application No. 10/614,733. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

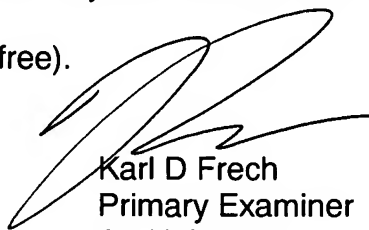
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech
Primary Examiner
Art Unit 2876
